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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

SC
#16
3/15/04

In re application of:) Examiner: Stephen S. Hong
)
Michael D. Myers et al.) Art Unit 2178
)
Serial No. 09/945,456)
)
Filed: August 30, 2001)
)
For: DOCUMENT CONVERSION AND)
NETWORK DATABASE SYSTEM)

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE U.S. POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR PATENTS, P.O. Box 1450, Alexandria, VA 22313-1450 ON 3-3-04

BY:KIRA LUTCHENKOV

RESPONSE TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is response to the Office Action of February 10, 2004. Applicant elects, with traverse, the claims of Group I as defined by the Examiner. This election is made with traverse.

It is respectfully submitted that the election requirement is improper. For such a requirement to be proper, the inventions have to be independent and distinct according to 35 U.S.C. § 121. Also, see MPEP § 802.01.

For the inventions to be independent, there must be no disclosed relationship between the two or more subject matters disclosed, that is, "they are unconnected in design, operation or effect. . ." MPEP § 802.01. Clearly, there is disclosed a relationship between the subject matter of claims 1 of Group I and Group II.

For the inventions to be distinct, they must be patentable over each other. MPEP § 802.01. Stated another way, if the Examiner finds prior art that anticipates the claims of

Group I, would it be the Examiner's position that the claims of Group II are patentable over that art? Similarly, if the Examiner finds prior art that anticipates the claims of Group II, is it the Examiner's position that the claims of Group I are patentable over that art? Only if the answer to both of these questions is affirmative, should the restriction requirement be maintained.

Respectfully submitted,

SHELDON & MAK

By _____
Jeffrey G. Sheldon
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Date 3-5-04

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